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10/718,531	11/24/2003	Beatrice Perron	235208US0	1996
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
DELCOTTO, GREGORY R				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
08/08/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/718,531

Applicant(s)

PERRON ET AL.

Examiner

Gregory R. Del Cotto

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 24-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 24-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-21 and 24-30 are pending. Claims 22 and 23 have been canceled.
Applicant's amendments and arguments filed 4/28/08 have been entered.

Objections/Rejections Withdrawn

The following objections/rejections as set forth in the Office action mailed 4/4/07
have been withdrawn:

None.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which
papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that
form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed
publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public
use or on sale in this country, more than one year prior to the date of application for patent in the United
States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

Art Unit: 1796

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8, 9, 13-17, 20, 21, and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofrichter et al (US 2003/0108501).

Hofrichter et al teach a shampoo composition containing 5 to about 50 percent of a surfactant, at least about 0.1 weight percent of particles having a mean particle size of less than about 300 microns, at least about 0.05 weight percent of a cationic polymer, and at least about 20 weight percent of an aqueous carrier. See paras. 10-14. The particles have a particle size from about 0.01 microns to about 80 microns and suitable particles include magnesium aluminum silicate, calcium carbonate, etc. The particles are present in no more than 20% by weight. See paras. 53-57. Additionally, the shampoos of the composition may contain a suspending agent in amounts from about 0.1% to about 10% by weight and suitable suspending agents include polyacrylamide, polyethyleneimine, etc. See para. 192 and 193.

Hofrichter et al do not teach, with sufficient specificity, a composition or method of using such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition and use such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine,

and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Hofrichter et al suggest a composition and method of using such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 1-3, 5-15, 17-21, and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutierrez et al (US 5,955,415).

Gutierrez et al teach detergent compositions, essentially free of chlorine bleach compounds, containing a surfactant, builder, enzyme, peroxygen bleach and from about 0.00% to about 5% by weight polyethyleneimine or salts thereof. These compositions exhibit controlled and improved bleaching action on stains as well as improved storage stability, fabric safety and whitening/brightening characteristics. See Abstract. Suitable detergent builders include crystalline aluminosilicate builder materials which have a particle size from 0.2 to 4 microns. Additionally, other detergent builders include seeded builder mixtures having a 3:1 mixtures of sodium carbonate and calcium carbonate having 5 micron particle diameter. The builders comprise from about 5% to about 80% by weight of the composition. See column 13, line 65 to column 17, line 60. The polyethyleneimines suitable for use have the same general formula as recited by instant claims 7 and 18. The polyethyleneimines are suitable for use in a variety of

compositions including shampoos, conditioning shampoos, etc. See column 44, line 60 to column 45, line 10.

Gutierrez et al do not teach, with sufficient specificity, a composition and method of using such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a composition and use such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Gutierrez et al suggest a composition and method of using such a composition to clean/condition hair containing solid mineral particles, at least one polyalkyleneimine, and the other requisite components of the composition in the specific proportions as recited by the instant claims.

Claims 7, 10-12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hofrichter et al (US 2003/0108501) as applied to claims 1-6, 8, 9, 13-17, 20, 21, and 24-26 above, and further in view of Gutierrez et al (US 5,955,415).

Hofrichter et al are relied upon as set forth above. However, Hofrichter et al do not teach the use of the specific polyethyleneimine as recited by the instant claims.

Gutierrez et al are relied upon as set forth above.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to use the specific polyethyleneimine as recited by instant claims in the composition taught by Hofrichter et al, with a reasonable expectation of success, because, Gutierrez et al teach that specific polyethyleneimines as recited by the instant claims are useful in shampoo compositions and further, Hofrichter et al teach the use of polyethyleneimines in general.

Response to Arguments

Applicant states that the previously submitted Rule 132 Declaration are sufficient to rebut any prima facie case of obviousness by showing the unexpected and superior properties of the claimed invention. Also, Applicant states that in these Declarationx, compositions which were virtually identical except for the amount of polyethyleneimine and solid mineral particles present were compared. Furthermore, Applicant states that the claimed invention requires the polyalkyleneimine/mineral particle weight ratio to be 0.05-0.0001 and neither Hofrichter nor Gutierrez teach or suggest this require ratio as recognized in the Office action (pages 4 and 6 of the Office action) which states that the cited references do not teach the requisite components in the specific proportions as required by the instant claims.

With respect to the Declarations filed under 37 CFR 1.132 which were submitted on 11/8/07 and 7/27/06, the Examiner maintains, as stated previously, that these Declarations are not sufficient to show the unexpected and superior properties of the claimed invention in comparison to those compositions falling outside the scope of the instant claims. Again, note that, while Applicant has provided data with respect to three,

single embodiments falling within the scope of the instant claims, the data presented in the Declarations is not commensurate in scope with the instant claims. The instant claims broadly recite solid mineral particles and at least one polyalkyleneimine wherein the composition has a particle weight ratio of polyalkyleneimine/mineral particle of 0.01 to 0.0001 while the Declarations provide data and evidence with respect to only three embodiments of the claimed invention which is not commensurate in scope with the claimed invention. While Applicant states at paragraph 9) of the Declaration filed 11/8/07 that it would be expected that other compositions falling within the scope of the instant claims would possess improved smoothness properties like those of the exemplified composition and has no reason to expect otherwise, the Examiner maintains, as stated previously, that this is the opinion of the Applicant, and this contention is not supported by any factual data. The Examiner has not completely disregarded Applicant's statement in paragraph 9 since the Examiner has considered the statement in paragraph 9 but has not found the statement to be persuasive. Note that, to be of any probative value, any objective evidence should be supported by actual proof. See In re De Blauwe, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); MPEP 716.01(c). Thus, the Examiner maintains, as stated previously, that the data presented in the Declarations filed under 37 CFR 1.132 is not sufficient to overcome the rejections as set forth above.

With respect to the rejection of the instant claims under 35 USC 103 using Gutierrez, Applicant state that the Gutierrez teaches bleach containing compositions which the composition as recited by the instant claims are used as shampoos and rinse-

out conditioners. In response, note that, the Examiner asserts that the instant claims recite "comprising" which would not exclude the presence of peroxygen bleach as required in the compositions taught by Gutierrez. Furthermore, the Examiner asserts that a shampoo or a rinse-out conditioner as recited by the instant claims is merely an intended use of the composition and is not read as a patentable limitation. Note that, if the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention and the preamble merely states, for example, the purpose or intended use for the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999); Kropa v. Robie, 187 F.2d at 152, 88 USPQ2d at 480-81. See MPEP 2111.02.

With respect to instant claims 27 and 28, Applicant states that Gutierrez states that these claims require less than 5% of the claimed mineral particles while Gutierrez discloses that his detergent compositions contain between 5 and 80% of detergent builder. In response, note that, the Examiner asserts that claim 27 recites "in an amount between 0.1 and 5% by weight" and for purposes of claim interpretation, this range would include the endpoint of 5% by weight which overlaps with "about 5% by weight" of builder as taught by Gutierrez. With respect to instant claim 28, the Examiner asserts that a builder in an amount of "about 5% by weight" as taught by Gutierrez would overlap with 3% by weight as recited by instant claim 28. Alternatively, even if "about 5% by weight as taught by Gutierrez does not overlap with 3% by weight as

recited by the instant claims, which the Examiner clearly is not conceding, the Examiner asserts that one of ordinary skill in the art would have a reasonable expectation of success to formulate the composition of Gutierrez using 3% by weight of builder from a teaching of about 5% by weight of builder due to an expectation of similar properties at about 5% by weight and 3% by weight builder. Note that, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05.

With respect to the rejection of the instant claims under 35 USC 103 using Hofrichter, Applicant states that nothing in Hofrichter teaches, suggest, or recognizes any benefits associated with actually combining PEI and solid mineral particles in a shampoo or a rinse-out conditioner. In response, note that, the Examiner asserts that Hofrichter teaches the use of PEI as a suspending agent in a shampoo composition in conjunction with solid mineral particles in the same amounts as recited by the instant claims. Furthermore, while Hofrichter may not use PEI in combination with solid mineral particles for the same reason as Applicant, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. Note that, while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the

claimed invention. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). See MPEP 2144. Thus, the Examiner maintains that the teachings of Hofrichter are sufficient to render the claimed invention obvious under 35 USC 103.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregory R. Del Cotto/
Primary Examiner, Art Unit 1796

/G. R. D./
August 4, 2008